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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,537	09/07/2001	Thomas Heering	T.HEERING	9176
20583	7590	10/03/2007		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER LIVERSEDGE, JENNIFER L	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/856,537	HEERING, THOMAS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/856,537 filed on August 3, 2007.

The amendment contains previously presented claims: 3 and 6-10.

The amendment contains amended claims: 1.

Claims 2, 4-5 have been canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 765 068 A2 to Yzhak Ronen (further referred to as Ronen).

Regarding claim 1, Ronen discloses a method of billing a fee for a service via an electronic route (column 1, line 55 – column 2, line 19; column 4, lines 50-59), comprising the steps of:

- a) transmitting a telephone number of a chargeable service telecommunication connection associated with a service provider to a service buyer (column 5, line 58 – column 6, line 4; column 9, lines 1-7; column 10, lines 3-10);

- b) monitoring a build-up of the telecommunication connection between the provider and the buyer by a line provider (column 6, lines 9-38);

- c) billing the fee for a requested service via the service connection (column 5, line 58 – column 6, line 19; column 7, lines 18-51; column 9, lines 12-16); and

- d) releasing the requested service to the buyer by the service provider, whereby an order code is allocated and transmitted to the service buyer during transmission of the telephone service number by the service provider (column 1, line 55 – column 2, line 19; column 2, lines 34-59; column 9, lines 37-45).

Ronen discloses wherein the service connection is a direct-dial connection having a direct-dial number which is used as the order code (column 1, line 55 – column 2, line 19; column 2, lines 34-59; column 6, lines 16-29; column 9, lines 37-45). Ronen discloses where the call to a direct-dial 900 number is associated with the user's

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request, the 900 number and an identification number are both part of the code package for associating the request with the user. (column 1, line 55 – column 2, line 19 and column 2, lines 34-59; column 6, lines 16-29; column 9, lines 37-45). It would be obvious to one of ordinary skill in the art at the time of the invention to use the direct-dial number as an order code. It was known to associate the calling number, the dialed number, and a session identifier with a given request for service. It would be obvious to use any of the associated numbers as an order code for the requested service.

Regarding claim 3, Ronan discloses the method wherein the requested service is billed after the order code has been confirmed by the service buyer (column 2, lines 34-53; column 3, lines 18-34; column 9, lines 1-7; column 10, lines 8-17).

Regarding claim 6, Ronan discloses the method wherein the service connection is disconnected by the service provider following the complete billing of the fee for the requested service (column 6, lines 20-30).

Regarding claim 7, Ronan does not specifically disclose the method wherein billing is terminated if the service line is disconnected before complete billing of the fee for the requested service. However, Ronan discloses billing for services provided by an ISP to a user by way of a telephone number for affecting those charges (column 1, line 55 – column 2, line 19; column 5, line 58 – column 6, line 4). It would be obvious to one of ordinary skill in the art that if the service were to be interrupted such that that service

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was not provided, then the billing would accordingly be terminated. Ronan discloses billing for services. If no service is provided, then it would be inappropriate to charge the user for a service they did not receive.

Regarding claim 8, Ronan discloses the method wherein billing is carried out continuously in parallel with transmission of the service (column 6, lines 9-25; column 9, lines 11-16).

Regarding claim 9, Ronan discloses the method wherein the line to the service connection is built up automatically on the side of the buyer (column 2, lines 5-19 and lines 34-53; column 5, line 58 – column 6, line 19; column 7, lines 18-21; column 9, lines 1-15; column 10, lines 3-17).

Regarding claim 10, Ronan discloses the method wherein the requested service is built up via the Internet (column 1, line 55 - column 2, line 19; column 4, lines 50-59; column 5, line 58 – column 6, line 29; column 7, lines 18-56; column 9, lines 1-15; column 10, lines 3-37).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3 and 6-10 have been considered but are moot in view of the new ground(s) of rejection.

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### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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A handwritten signature in black ink, appearing to read 'Kambiz Abdi', with a stylized flourish at the end.

Kambiz Abdi

Supervisory Patent Examiner

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